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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,893	06/17/2005	Marvin P. Loch	TDYNE-308-CIP	3585
2387	7590	05/29/2007		
OLSON & HIERL, LTD. 20 NORTH WACKER DRIVE 36TH FLOOR CHICAGO, IL 60606			EXAMINER HEALY, BRIAN	
			ART UNIT 2883	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/539,893

Applicant(s)

LOEB, MARVIN P.

Examiner

Brian M. Healy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13-37 is/are rejected.
- 7) ☒ Claim(s) 9-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/17/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

Claims 9-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the references of record teaches or suggests the claimed features of : open aperture is situated on a sidewall of the hollow sheath (claim 9) and the open aperture is occluded with a balloon (claims 10,11,12).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 37 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 25 of prior U.S. Patent No. 6,953,458. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 13-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,953,458. Although the conflicting claims are not identical, they are not patentably distinct from each other because: Although claim 1 of the application and claim 1 of the 458' patent are not identical to each other they are nevertheless not patentably distinct. The use of the term "open aperture" in claim 1 of the application is not patentably distinct in scope from the recited "open distal end" of claim 1 of the 458' patent. Claim 1 of the application is broader than the claims of the patent and does not preclude the addition of other structural elements. Claim 2 of the application is identical to claim 9 of the patent. Claim 3 of the application is identical to claim 11 of the patent. Claim 4 of the application is identical to claim 12 of the patent. Claim 5 of the application is identical to claim 13 of the patent. Claim 6-8, 13,14, 15, 18,19 of the application are covered by claim 1 of the patent. Claim 16 of the application is identical to claim 14 of the patent. Claim 17 of the application is identical to claim 15 of the patent. Claim 20 of the application is identical to claim 2 of the patent. Claim 21 of the application is identical to claim 3 of the patent. Claim 22 of the application is identical to claim 4 of the patent.

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Claim 23 of the application is identical to claim 5 of the patent. Claim 24 of the application is identical to claim 6 of the patent. Claim 25 of the application is identical to claim 7 of the patent. Claim 26 of the application is identical to claim 8 of the patent. Claim 27 of the application is identical to claim 10 of the patent.

Although claim 28 of the application and claim 16 of the 458' patent are not identical to each other they are nevertheless not patentably distinct. The use of the term "open aperture" in claim 28 of the application is not patentably distinct in scope from the recited "open distal end" of claim 16 of the 458' patent. Claim 1 of the application is broader than the claims of the patent and does not preclude the addition of other structural elements. Claim 29 of the application is identical to claim 17 of the patent

Claim 30 of the application is identical to claim 18 of the patent. Claim 31 of the application is identical to claim 19 of the patent. Claim 32 of the application is identical to claim 20 of the patent. Claim 33 of the application is identical to claim 21 of the patent. . Claim 34 of the application is identical in scope to claim 22 of the patent. Claim 35 of the application is identical in scope to claim 23 of the patent. Claim 36 of the application is identical in scope to claim 24 of the patent.

The following references are also cited by the Examiner as being pertinent prior art: Fumich, U.S.P. No. 5,352,221 (Figs.1-8), Goldenberg et. al., U.S.P. No. 5,470,330 (Figs.1-38), Dobak, III, U.S.P. No. 6,182,666 (Figs.1-17) and Dobak, III, U.S.P. No. 6,451,012 (Figs.1-17).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian M. Healy whose telephone number is (571)272-2347. The examiner can normally be reached on Compressed. schedule Mon.-Fri. 6AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571)272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Brian M. Healy**  
**Primary Examiner**  
**Art Unit 2883**

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**BRIAN HEALY**  
**PRIMARY PATENT EXAMINER**